

Remarks

Claims 27-32 and 89-92 have been amended leaving claims 27-34 and 89-92 pending in the application.

Claims 27-34 stood rejected under 35 U.S.C. § 102(b) as being anticipated by Gardano et al. (U.S. Patent No. 4,885,490). Claims 90-91 stood rejected under 35 U.S.C. § 102(b) as being anticipated by DE4203351. Claim 92 stood rejected under 35 U.S.C. § 102(b) as being anticipated by GB 212066. Claim 89 stood rejected under 35 U.S.C. § 103(a) as being unpatentable over GB 212066. Applicant requests reconsideration of these rejections in view of the amendments to the claims.

The Examiner should appreciate the need to reevaluate the combination of cited references in light of the amendments herein to the claims. Simply looking in such references or others for the changed or added limitations is not sufficient. Such reevaluation is required because the prior art must suggest to those of ordinary skill in the art, "that they should make the claimed composition or device, or carry out the claimed process." In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991) (emphasis added). Further, the text of 35 U.S.C. § 103(a) requires that "the subject matter as a whole" must be obvious rather than select elements. Applicant asserts that, with the claim amendments, the subject matter of the claims is transformed such that if a suggestion or motivation to combine the cited references previously existed, then it does not now. The mere fact that the prior art can be modified does not

make the modification obvious "unless the prior art suggested the desirability of the modification." In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). "When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over An earlier decision should not . . . be considered as set in concrete, and applicant's rebuttal evidence then be evaluated only on its knockdown ability." In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (C.C.P.A. 1976) (emphasis added).

For example, claim 27 has been amended to recite a hydrogenation process that includes contacting a **fluorinated compound** with a **hydrogenation catalyst** in the presence of **water** to form a **hydrogenated compound comprising both hydrogen and fluorine**. (emphasis added). The Examiner has recognized that the prior art does not describe all the features of claim 27. As such, claim 27 is novel in view of the cited references.

Claim 27 is also non-obvious in view of the cited references. The Examiner is respectfully referred to MPEP §2142, which recites, in part:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, Applicants note that the Federal Circuit has determined that the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem.” *Diversitech Corp. v. Century Steps Inc.*, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988). If the references do not address or even recognize the problem they cannot begin to teach or suggest a solution to it. None of the references cited in the Office Action addresses the problem solved by embodiments of Applicant’s disclosure and, accordingly, cannot suggest a solution to such problem. The Federal Circuit further stated that “the nature of the problem ‘which persisted in the art,’ and the inventor’s solution, are factors to be considered in determining whether the invention would have been obvious to a person of skill in that art.” *Northern Telecom v. Datapoint Corp.*, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990). In *Northern Telecom*, the Federal Circuit confirmed a finding that the claims were valid in view of prior art that did not “suggest the [inventors’] solution” to a problem. *Id.* at 1323-24.

In accordance with embodiments of the present disclosure, hydrogenation catalyst life is extended when the reagents are reacted in the presence of water. The cited references do not teach or suggest the extension of catalyst life. As such, it is understandable that a person of ordinary skill in the art would not be motivated to utilize water during the use of a hydrogenation catalyst after reviewing the cited references. Further, there is a wealth of literature that indicates the use of water

during hydrogenation inhibits hydrogenation. For at least these reasons, claim 27 is allowable.

Claims 28-34 and 89-92 depend from claim 27 and are allowable for at least the reasons given above regarding claim 27.

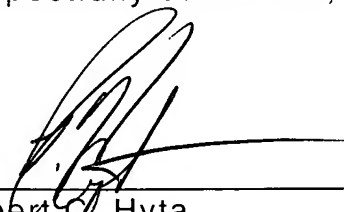
In addition, there remains prior art which was properly and timely submitted by Applicant, but Applicant has not received the Examiner initialed PTO-1449. On the Information Disclosure Statement submitted on October 31, 2003, a portion of sheet 1 of 4 has not been initialed. On the Supplemental Information Disclosure Statement submitted on April 30, 2004, the article cited has not been initialed. Also, the Supplemental Information Disclosure Statement submitted October 21, 2004, Applicant has not received the Examiner initialed PTO-1449 of the PCT international preliminary examination report cited. Copies of each above-referenced Supplemental IDS with its accompanying Form PTO-1449 are included herewith, along with proof of receipt by the U.S. Patent and Trademark Office in the form of a copy of the PTO-stamped return receipt postcard. It is requested that the Examiner consider these prior art references, and that the Examiner initial them on the Form PTO-1449. Such is not seen to be discretionary with the Examiner. See MPEP §§609(C)(2) and 609(D). Also, the undersigned respectfully requests to be provided with copies of the Examiner initialed PTO-1449.

The Examiner is requested to telephone the undersigned if the Examiner believes such would facilitate prosecution of the present

application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Standard Time).

Respectfully submitted,

Dated: 1/12/07

By: 
Robert C. Hyta
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